

REMARKS

Applicant submits this Response in response to the Office Action mailed November 28, 2005. Applicant has cancelled claims 10 and 26 (without prejudice to re-presenting the subject matter of these claims at a later time). Claims 1-9, 11-25 and 27-28 are currently pending. No new matter has been added.

In the Office Action, the Examiner rejected claims 10 and 26 under 35 U.S.C. § 112, ¶1, as failing to comply with the enablement requirement. The Examiner rejected claims 1-9, 11-25 and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0147811 to Schwartz et al. ("Schwartz") in view of U.S. Patent No. 6,665,388 to Bedingfield ("Bedingfield") and further in view of U.S. Patent No. 6,240,449 to Nadeau ("Nadeau"). The Examiner also rejected claims 10 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Schwartz in view of Bedingfield and further in view of U.S. Patent Application Publication No. 2003/0147518 to Albal et al. ("Albal") or Nadeau. As Applicant has cancelled claims 10 and 26, the rejections of these claims is now moot. Applicant traverses the rejection of the remaining claims and respectfully requests withdrawal of these rejections based on the following.¹

Rejections of Claims 1-9, 11-25 and 27-28 Under § 103

Independent claim 1 recites "[a] method for supplying calling party information to a called party" that includes:

- receiving by the gateway device, via the telephone network, signaling information representing a telephone call from the calling party to a telephone device associated with the called party, the signaling information comprising called party information;
- obtaining the calling party information based on the signaling information;
- determining whether a second device associated with the called party and separate from the telephone device is connected to the data network;

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references) is not a concession by Applicant that such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

storing the calling party information when the second device is not connected to the data network; and
providing the stored calling party information to the second device associated with the called party from the gateway device via the data network when the second device becomes connected to the data network.

Independent claims 11 and 18, although of different scope, contain recitations similar to those of claim 1.

The Examiner concedes that "Schwartz fails to teach providing calling party information on a second device associated with the called party." (Office Action, p. 4.) In order to cure this deficiency, the Examiner relies upon the description in Bedingfield. However, neither Schwartz nor Bedingfield describe a method that includes all of the elements of claim 1. For example, neither Schwartz nor Bedingfield describe a method that determines whether a second device associated with the called party and separate from the telephone device is connected to the data network, stores the calling party information when the second device is not connected to the data network, and provides the stored calling party information to the second device associated with the called party from the gateway device via the data network when the second device becomes connected to the data network.

The Examiner ocites Nadeau as teaching "PSTN and data network used to allow users the ability to choose to complete calls through the PSTN at specified times or route over the Internet when device currently connected (abstract, col. 4 lines 2-45, col. 9 line 18-col. 11 line 32, col. 11 lines 61-64, col. 12 lines 1-4, col. 12 lines 21-31, col. 12 lines 49-52)." (Office Action, p. 5.) As an initial matter, the technology the Examiner has noted as being allegedly taught by Nadeau does not map to the exemplary elements identified as missing from Schwartz and Bedingfield. As noted above, claim 1 includes:

determining whether a second device associated with the called party and separate from the telephone device is connected to the data network;
storing the calling party information when the second device is not connected to the data network; and
providing the stored calling party information to the second device associated with the called party from the gateway device via the data network when the second device becomes connected to the data network.

The Examiner's assertion appears to be that the system described in Nadeau makes a determination whether a device is currently connected to the Internet. Assuming this is accurate, the Examiner does not assert that the system described in Nadeau stores calling party information when the device is not connected, and then provides the stored calling party information to the second device when the second device becomes connected. As a result, the Examiner has not made a prima facie showing of obviousness in view of the proposed combination of the Schwartz, Bedingfield and Nadeau references.

More significantly, a review of the Nadeau reference itself indicates that in fact at least the claimed "storing" and "providing" elements noted above are not taught by Nadeau. Nadeau describes an embodiment of a VoIP-enabled communication system where a "pseudo address" may be used to obtain the IP address associated with a called party – if the called party is connected to the Internet, the "gatekeeper functional element" associated with the user's device will provide the IP address of the device. (Nadeau, col. 11 line 65 to col. 12 line 4, col. 12 lines 53-58.) If the called party is not connected to the Internet (no routing information is available), the default call routing algorithm completes the call using the PSTN. (Id., col. 11, lines 13-20.) Nadeau does not, however, describe storing calling party information when a second device is not connected to the data network and then providing that stored calling party information to the second device when the second device becomes connected to the data network.

The absence of all of the elements of claim 1 from the descriptions in the Schwartz, Bedingfield and Nadeau references indicates that claim 1 is patentable over these references (even if it is permissible to combine these references as proposed by the Examiner). For at least these reasons, Applicant thus believes claim 1 to be patentable over Schwartz, Bedingfield and/or Nadeau, whether taken alone or in combination. Claims 11 and 18, although of different scope, include elements similar to those discussed above with respect to claim 1, and therefore Applicant believes claims 11 and 18 to be patentable over Schwartz, Bedingfield and/or Nadeau as well. Accordingly, Applicant respectfully requests that the rejections of claims 1, 11 and 18 under 35 U.S.C. § 103(a) be withdrawn.

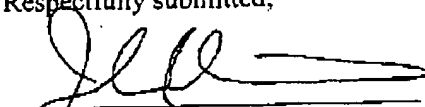
Claims 2-9, 12-17, 19-25 and 27-28 are each ultimately dependent from one of independent claims 1, 11 or 18, and therefore include all of the limitations of these claims. As a result, Applicant believes claims 2-9, 12-17, 19-25 and 27-28 to be patentable over the Schwartz, Bedingfield and/or Nadeau references for at least the same reasons as claims 1, 11 and 18,² and respectfully requests that the Examiner withdraw the rejections of claims 2-9, 12-17, 19-25 and 27-28 under 35 U.S.C. § 103(a) as well.

² As Applicant's remarks with respect to the basic independent claims are sufficient to overcome the Examiner's rejections of all claims dependent therefrom, Applicant's silence as to the Examiner's assertions with respect to dependent claims is not a concession by Applicant to the Examiner's assertions as to these claims, and Applicant reserves the right to analyze and dispute such assertions in the future.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that the pending claims are in condition for allowance. Reconsideration and allowance are respectfully requested. If there are any outstanding issues which need to be resolved to place the application in condition for allowance, the Examiner is invited to contact Applicant's undersigned representative by phone at the number indicated below to discuss such issues. To the extent necessary, a petition for extension of time under 37 C.F.R. § 1.136 is hereby made, the fee for which should be charged to deposit account number 07-2347. With respect to this application, please charge any other necessary fees and credit any overpayment to that account.

Respectfully submitted,

April 28, 2006
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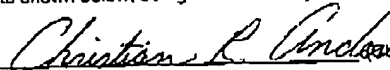
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CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this correspondence is, on the date shown below, being transmitted by facsimile to the United States Patent Office at 571-273-8300.

Dated: April 28, 2006

Signature:


Christian R. Andersen